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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/944,379	09/04/2001	Wolfgang Moderegger	007413-049	1270

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EXAMINER
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ADE, OGER GARCIA

ART UNIT	PAPER NUMBER
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3627

DATE MAILED: 12/01/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/944,379

Applicant(s)

MODEREGGER ET AL.

Examiner

Garcia Ade

Art Unit

3627

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on September 17th 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-43 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-43 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Claims 49 – 56, and 59 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected Group II, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on August 17<sup>th</sup>, 2006. Applicants remarks have been reviewed, but are not convincing. A serious burden exists upon the present Examiner to properly provide proper examination of the application. Thus, the restriction is maintained.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1 - 3, 7 - 10, 13 - 15, 18, 19, 26, 33, 38 - 41, and 43 are rejected under 35 U.S.C. 102(e) as being anticipated by Fields [US 2002/0069154].

**As per claims 1, 2, 12 – 15, 18, 19, 26, 33, 38 – 41, and 43,** Fields discloses a computer-implemented method for fulfilling an invitation for bids , comprising: providing a database [see flowchart of figure 1, block 14], comprising at least one performance description and at least one price description for each of a plurality of predetermined performances [see paragraph 55]; generating a list of

unpriced performances [see paragraph 93] desired by a buyer by selecting at least one of the predetermined performances from the database and by including the respective performance description in the list of performances [see abstract of the invention and see paragraphs 19, 24, 26, and 67]; forwarding the list of unpriced performances to a plurality of bidders, receiving a bid from at least one of the plurality of bidders [see abstract (e.g. **means for receiving bids**), and paragraph 27 (e.g. **means for distributing request for proposal**)], each received bid including a bid price input to a bid mask by the bidder and assigned to at least one performance description of the list of unpriced performances, the bid price stating the price to be paid to the bidder for effecting the respective performance by the bidder [see first paragraph of the summary of the invention (e.g. customized fee quote based upon **client inputs**)]; evaluating the received bids and selecting a bid from the bids received [see paragraph 86 (e.g. figures 21 and 24, after the client completes a request, he is taken to a page which lays out a **calculated fee and RFP** based the information input into the system)]; and updating the database such that, for each performance of the generated list of performances for which a bid is selected, the price description in the database corresponding to said performance is modified to reflect the selected bid, wherein at least the updating is performed by a computer [see paragraph 28].

**As per claims 3 and 12,** Fields discloses generating the list of performances includes modifying at least one performance description in the list of performances, and wherein updating the database includes automatically updating the price description corresponding to bid performances whose performance description was

Art Unit: 3627

not modified [It is noted that the performance description is updated, for example specifying a number of moving parts in the invention, and see paragraph 62, via client **Start Page 56A** permits the client to **renew** and delete].

**As per claims 7 - 9**, Fields discloses the step of generating the list of performances also includes generating an estimated bid which includes an estimated price for at least one desired performance of the a generated list of performances [see paragraph 47].

**As per claim 10**, Fields discloses the price description of the performance in the database comprises prices independent of the region in which the predetermined performance is to be effected, and wherein the database further comprises at least one regionally dependent price correction term for a plurality of regions in which the predetermined performance is to be effected [see paragraph 80 (e.g. in the database 14 based upon empirical evidence of **regional and national prices** for intellectual property services)].

#### **Claim Rejections - 35 USC § 103**

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 4 - 6, 11, 16, 20, 21, 34 - 36, and 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fields.

**As per claims 4 - 6,** Fields shows all elements except modifying or adding a performance and saving it in the database as a new performance. However, the examiner takes official notice that to do so is notoriously old and well known in the art. It would have been obvious to one of ordinary skill in the art to modify the method Fields by modifying or adding and saving performance descriptions as new performances in order to provide a more comprehensive listing of performance descriptions for future users to choose from.

**As per claim 11,** Fields shows all elements except determining the price of a performance from the region-independent price and a regionally dependent price correction term and updating only the independent price. However, the examiner takes official notice that to determine and update a regional price in this way is notoriously old and well known in the art. It would have been obvious to one of ordinary skill in the art to modify the method Fields by applying a regional correction term to an independent price in order to facilitate easy database maintenance.

Additionally as per claim 11, Fields shows all elements except providing regionally dependent price correction term and determining the price of a performance from the region-independent price and a regionally dependent price correction term. However, it would have been an obvious matter of design choice to determine regional prices in this way since it does not appear that this particular method of determining regional prices solves a particular problem or is for a specific purpose, and it appears that the method would function equally well with either method.

**As per claim 16**, Fields shows all elements except securing the list upon its completion. However, the examiner takes official notice that to do so is notoriously old and well known in the art. It would have been obvious to one of ordinary skill in the art to secure the created list in order to ensure that the list is not changed during the bidding process, creating inaccurate bids.

**As per claim 20**, Fields shows all elements except not disclosing the bid to the buyer. However, the examiner takes official notice that to do so is notoriously old and well known in the art. It would have been obvious to one of ordinary skill in the art to maintain bids secret until the deadline in order to prevent bid rigging.

Additionally, it is noted that claim 20 is interpreted as an obvious variant over claim 19. Were it determined that claim 20 is patentably distinct from claim 19, a species requirement would be necessary.

**As per claim 21**, Fields shows all elements except showing time of receipt of a bid. However, the examiner takes official notice that to do so is notoriously old and well known. It would have been obvious to one of ordinary skill in the art to include the time of receipt in order to maintain good housekeeping records and to provide proof that the bid arrived before the deadline.

**As per claim 34**, Fields shows all elements except automatic notification of losing bidders. However, the examiner takes official notice that to do so is notoriously old and well known in the art (e.g., ebay). It would have been obvious to one of ordinary skill in the art to modify the method Fields by providing such notification in order to ensure timely notification of losing bidders.

**As per claims 35 and 36**, Fields shows all elements except automatically sending a list of performances to the winning bidder. However, the examiner takes official notice that to do so is notoriously old and well known in the art. It would have been obvious to one of ordinary skill in the art to generate and provide such a list in order to facilitate the creation of a contract between the bidder and buyer in a timely manner.

**As per claim 42**, Fields shows all elements except the price description comprising a performance description comprising time to perform a performance, and a rate per hour. However, the examiner takes official notice that to do so is notoriously old and well known in the art (e.g., determining the cost of an auto repair by retrieving the "book rate" time to perform the repair and multiplying it by the labor rate). It would have been obvious to one of ordinary skill in the art to modify the method of Fields by providing such a way of determining the price in order to quickly determine a price of a number of jobs based on differing complexity and labor costs.

6. Claims 17, and 27 - 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fields in view of Slaight et al. [US 2002/0077954].

**As per claims 17, 31 and 32**, Fields discloses all elements per claimed invention as explained above. Fields does not explicitly disclose receiving bids includes receiving several bids from each of several bidders, with the last bid received from each bidder being used for bid evaluation and selection; the bids are made available to a chosen few of the submitting bidders such that each of the chosen bidders can inspect the bids of the remaining chosen bidders, and wherein



each of the chosen bidders can submit modifications of their respective bid prices; and an auction end time is determined after which modifications can no longer be received.

However, Slaight discloses receiving bids includes receiving several bids from each of several bidders [see abstract of the invention], with the last bid received from each bidder being used for bid evaluation and selection [see paragraph 57 (e.g. the implementor may ***evaluate the suitability of the auction*** for the category using many different criteria)]; the bids are made available to a chosen few of the submitting bidders such that each of the chosen bidders can inspect the bids of the remaining chosen bidders [see figures 25A and 25B], and each of the chosen bidders can submit modifications of their respective bid prices [see paragraph 75 (e.g. modify pre-existing information), and figure 6]; and an auction end time is determined after which modifications can no longer be received [see paragraph 89 (e.g. duration of the auction including the start date time and end date time)].

Therefore, it would have been obvious to one of ordinary skill in the art to modify the method of Fields by providing feedback and allowing repeated bids in order to assist the bidder in fixing problems in his bid.

**As per claims 27 - 30**, Fields discloses all elements per claimed invention as explained above. Fields does not explicitly disclose generating a synthetic price from the ideal price calculated from the bid prices, and making the price available to bidders.

However Slaight discloses generating a synthetic price from the ideal price calculated from the bid prices [see e.g., Figure 33]; and making the price available to bidders [see figure 16A].

Therefore, it would have been obvious to one of ordinary skill in the art to modify the method of Fields by providing a synthetic price as claimed in order to assist in evaluating bids.

7. Claims 22 - 25, and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fields in view of Vashishta et al. [2001/0051913].

**As per claims 22 and 23**, Fields in view of Vashishta show evaluating the bids based on ideal price (comprising lowest price), estimated price, deviation from the lowest price and past performance.

**As per claims 24 and 25**, Fields in view of Vashishta show all elements except automatically determining a deviation from the ideal price. However, to do so is notoriously old and well known in the art. It would have been obvious to one of ordinary skill in the art to further modify the method of Fields by providing a deviation in order to assist in determining the best bid.

**As per claim 37**, Fields discloses all elements per claimed invention as explained above. Fields does not explicitly disclose the selected bid is selected automatically.

However, Vashishta disclose the selected bid is selected automatically [see paragraph 90 (e.g. ***automatically populated***)]. Therefore, it would have been obvious to one of ordinary skill in the art to modify the method of Fields by

automatically selecting a bid in order to reduce the amount of manual labor required in selecting the bid.

### ***Response to Arguments***

8. Applicant's arguments filed September 17<sup>th</sup>, 2006 have been fully considered but they are not persuasive.

A) Applicants argue with respect to claim 1 that Fields does not disclose any of the limitations recited in the claim. The Examiner respectfully disagrees. Fields published application describes the ability for individual and user customers to identify specific groups of attorneys to whom they wish to receive RFPs, which permits a potential client to identify a predetermined ***list of attorneys*** and choose his or her counsel. The Examiner also notes the abstract, paragraph 27, and the text of claims 1 and 2 explicitly recite the limitations of claim 1.

Even if it were assumed *in arguendo* that the attorneys' actions in Fields are limited to the attorney accepting, rejecting, or deleting the RFP, the attorneys by deciding whether or not to accept the suggesting fee are determining a bid price.

B) Applicants argue with respect to claims 17 and 27 - 32 that neither Fields nor Slaight disclose or suggest, all the features recited in the claims. The Examiner respectfully disagrees. The Examiner notes the abstract, paragraph 57, figures 33 and 16A from Slaight's published application explicitly recite the features of claims 17 and 27 - 32.

C) Applicants argue with respect to claims 22 – 25 and 37 that neither Fields nor Vashistha disclose or suggest, all the features recited in the claims. The Examiner respectfully disagrees. It is noted that all elements of the claims are disclosed in the Vashistha's published applications, see abstract and paragraph 90.

Therefore, Applicant's arguments are deemed nonpersuasive.

### ***Conclusion***

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Garcia Ade whose telephone number is 571.272.5586. The examiner can normally be reached on M-F 8:30AM - 5PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alexander Kalinowski can be reached on 571.272.6771. The

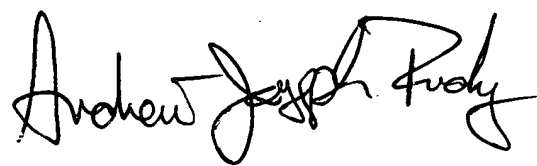
Art Unit: 3627

fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

11. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Garcia Ade  
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